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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,535	07/21/2003	Theirry Marnay	P07874US00/MP	3880
881	7590	08/30/2005		
STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314			EXAMINER PHILOGENE, PEDRO	
			ART UNIT 3732	PAPER NUMBER

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/622,535	MARNAY ET AL.	
	Examiner	Art Unit	
	Pedro Philogene	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 2-9,27-29 and 32-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,10-16,19-22,24-26,30,31 and 39-52 is/are rejected.
- 7) ☒ Claim(s) 17,18 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/6/04</u> | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Applicant's election without traverse of claims 1,10-26,30,31,39-52 in the reply filed on 6/14/05 is acknowledged. Claims 31,32, have been changed to claims 30 and 31.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,10-16, 19-22,24-26,30,31, 39-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson (5,720,751).

With respect to claims 1, 19, 24, Jackson discloses an instrument capable of inserting an intervertebral space comprising a pair of arms, as shown in FIGS. 22, 33, 15, 16; connected to each other and including an upper arm and a lower arm, the arms being closable towards each other capable of entering recesses in and securing an intervertebral implant therebetween and separable away from each other for removal from the intervertebral implant ; each arm including at its outer end a recess engaging portion (165) adapted to be inserted in a recess of an intervertebral implant; and a spacer (20) located between the arms to limit movement of the upper and lower parts towards each other when securing the implant; as best seen in FIGS. 18, 22.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

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patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With respect to claims 10-16, 20-22,25-26; Jackson discloses all the limitations; as best seen in FIGS. 14,15,16,18,22,23.

With respect to claims 30,31,39-52, the method steps, as set forth would have been inherently carried out in the operation of the device, as set forth above.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 10-12,24,30,31 are rejected under 35 U.S.C. 102(e) as being anticipated by Winterbottom et al. (20030083747).

With respect to claims 1, 24, Winterbottom et al. disclose an instrument for inserting an intervertebral implant into an intervertebral space comprising a pair of arms, as shown in FIG.68 connected to each other and including an upper arm and a lower arm, the arms being closable towards each other to enter recesses in and secure an intervertebral implant therebetween and separable away from each other for removal from the intervertebral implant ; each arm including at its outer end a recess engaging portion (440,442) adapted to be inserted in a recess of an intervertebral implant.; and pivot member (448).

With respect to claims 10-12, Winterbottom et al. disclose all the limitations; as set forth in page 14, para [0223] and as best seen FIG. 68.

With respect to claims 30,31 the method steps, as set forth would have been inherently carried out in the operation of the device, as set forth above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-16,19-22,25-26,39-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (5,720,751) in view of Winterbottom et al. (20030083747).

With respect to claims 13-16,19-22,25-26, it is noted that Winterbottom et al did not teach of a spacer limiting the movement of the upper and lower arms towards each other when securing the implant; as claimed by applicant. However, Jackson, in a similar art (insertor) evidences the use of a spacer that limit the movement of the upper and lower arms to drive, push or force an implant into a space or receiving channel.

Therefore, given the teaching of Jackson, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the spacer of Winterbottom et al., as taught by Jackson, to drive, force or push the implant into the receiving channel.

With respect to claims 39-52, the method steps, as set forth, would have been obviously carried out in the operation of the device, as set forth above.

Allowable Subject Matter

Claims 17, 18, 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

3,486,505	Morrison	12-1969
6,036,692	Burel et al.	03-2000

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene
August 18, 2005


PEDRO PHILOGÈNE
PRIMARY EXAMINER